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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/816,641	03/22/2001	Daniel Jacobs	235692000121	6872
26379	7590	05/03/2005		
DLA PIPER RUDNICK GRAY CARY US, LLP 2000 UNIVERSITY AVENUE E. PALO ALTO, CA 94303-2248				
			EXAMINER RAGONESE, ANDREA M	
			ART UNIT 3743	PAPER NUMBER

DATE MAILED: 05/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Advisory Action Before the Filing of an Appeal Brief	Application No. 09/816,641	Applicant(s) JACOBS ET AL.	
	Examiner Andrea M. Ragonese	Art Unit 3743	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 March 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because

(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);

(b) ☐ They raise the issue of new matter (see NOTE below);

(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: _____.

Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____

13. ☐ Other: _____.

Continuation of 11. does NOT place the application in condition for allowance because:

Applicant's arguments, with respect to the 112, first paragraph, rejection of claims 1-2, 8, 11-13, 16, 21, 24-26, 46-50 and 54-58, filed March 28, 2005 (see page 6), have been fully considered but they are not persuasive. Examiner still believes that the claims contain subject matter which was not described in the original specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the phrase "at least one attachment point extending from the front side of said backing in a non-orthogonal manner" lacks proper support in the original disclosure, and therefore, is considered new matter, which cannot be entered in an amendment.

Applicant's arguments, with respect to the 102(b) rejection of claims 1, 2, 13, 16, 21, 24-26 and 54, filed March 28, 2005 (see pages 7-8), have been fully considered but they are not persuasive. Regarding the amended claim limitation in claim 1 stating "in a non-orthogonal manner" and Applicant's argument that the prior art of record-Goble (US 5,352,229)-"does not teach or suggest the combination of a supportive backing and through-hole, with at least one attachment point extending from the backing in a non-orthogonal manner." The Examiner respectfully disagrees with this statement. The device has a supportive backing 31 with at least one through-hole 33, 34 formed therethrough and at least one attachment point 35 extending from the backing 31, (column 5, lines 55-68), as shown in Figure 2. The attachment point 35 extends from the backing 31 in a non-orthogonal manner, since the sides of the extension to which attachment point 35 is connected to the backing 31 project from the backing 31 at an angle to the surface from which they extend. There is no 90 degree angle between the side of the extension to which the attachment point 35 is connected; on the contrary, the angle is approximately 45 degrees, which would make the "at least one attachment point 35 extending from front side of said backing 31 in a non-orthogonal manner."

Applicant's arguments, with respect to the 103(a) rejection of claims 8, 11-12, 46-47 and 49, filed March 28, 2005 (see pages 8-9), have been fully considered but they are not persuasive. The Examiner would like to reiterate that it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Goble et al. by constructing it of a biodegradable and biological material that is flexible and porous because it is known in the art, as taught by Duncan, to use such a material in medical implant devices in order to provide a device that allows the tissue to heal while adjusting to fit into different configurations in the patient's body.

Applicant's arguments, with respect to the 103(a) rejection of claims 8, 46-47 and 49, filed March 28, 2005 (see page 9), have been fully considered but they are not persuasive. The Examiner would like to reiterate that it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Goble et al. by constructing it of a material capable of being shaped during surgery because it is known in the art, as taught by Tschakaloff, to use such a material in medical implant devices in order to adjust and mold the device fit properly into different configurations in the patient's body.

Applicant's arguments, with respect to the 103(a) rejection of claims 48 and 50, filed March 28, 2005 (see pages 9-10), have been fully considered but they are not persuasive. The Examiner would like to reiterate that it would have been obvious to modify the device of Goble et al. by altering the backing to have a curved surface because it is well known in the art to use a curved surface in an implant in order to more closely fit the contour of bodily tissue or bones.

The Examiner believes that the rejections as presented in the previous Office action were proper and clearly provided adequate disclosure for the 102 rejections and proper motivation for the 103 rejections. The arguments as stated by the Applicant are not persuasive and therefore do not overcome these rejections. Subsequently, the final rejection is deemed proper and still stands as set forth in the previous Office action.

Henry Bennett
Supervisory Patent Examiner
Group 3700